

NO.

2397

IN THE
United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT

DIAMOND PATENT COMPANY (a Corporation)
Appellant,

vs.

WEBSTER BROS. (a Corporation) and C. F.
MURRAY, et al,
Appellees.

DEFENDANTS' AND APPELLEES' BRIEF

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United States Circuit Court of Appeals
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DIAMOND PATENT COMPANY,	Plaintiff,	A 55 Equity
vs.		
WEBSTER BROS., (a Corporation),	Defendant,	A 60 Equity Consolidated
DIAMOND PATENT COMPANY,	Plaintiff,	
vs.		
C. F. MURRAY, et al.,	Defendants.	

DEFENDANTS' AND APPELLEES' BRIEF

This appeal is prosecuted by the plaintiff and appellant from the decision of the trial court in equity cases No. A-55 and A-60, the former being an action instituted by the plaintiff against the defendant in that case to enjoin the defendant in that case from the further use of certain show cases that the plaintiff alleged was being used in violation of the rights of the plaintiff as the owner of a patent upon all glass show cases, and the latter numbered case was an action for injunction against the defendant in that case to restrain and enjoin the defendant

in that case from the manufacture and sale of certain show cases that it was alleged were being manufactured and sold in violation of the rights of the plaintiff and appellant under the same patent, and in both cases the plaintiff and appellant prayed for an accounting by the defendants respectively.

The patent referred to was issued October 17th, 1905, to Fred Weber and appears attached between pages 16 and 17 of the transcript of the record on this appeal, to the provisions of which we call attention.

In the specifications it is set out from line 7 to line 11 that

“This invention relates to improvements in glass show cases; and the improvement resides particularly in the means for fastening one glass surface to another glass surface or to wood work forming a part of the case.”

And, at lines 24 to 35:

“Another object is to provide for a certain amount of elasticity at the joint, whereby a cushion effect is produced. If the parts were rigidly united, severe shocks received by the show-case would tend to shatter the plates or displace the parts; but in the present invention the cushion-joint aids in maintaining the union of the parts, affording as it does, an elastic or resilient joint, which eases the strain at the actual union or contact-faces of the plates, thereby also greatly softening the effects of shocks by the case.”

And, at lines 45 to 48:

“Figure 5 is a sectional view illustrating the method of fastening glass plates with an *intervening strip of molding*.”

Then at lines 48 to 56:

"The invention comprises in combination with the parts to be united such as glass or other material having a vitreous surface, a strip of *yielding material, such as felt*, which is interposed between the adjacent faces to be united, *each face of the yielding material having a coating of cement*, which forms the union between the yielding material and the surface of the adjacent part."

And lines 57 to 81:

"Referring particularly to Fig. 2, 1 designates the front plate. 2 is the side plate and 3 is the top plate resting upon the front and side plates *with a strip of felt 4*, which lies upon the top edge of the side plates 1 and 2, both top and bottom faces of the *felt 4* having a cement 5, which unites the plate to the *felt*. The cement is applied to the felt superficially forming a skin, as it were, *on both sides of the felt, the body of the felt thus retaining its natural state. If the cement were applied to the felt so as to permeate the same, by uniting with the felt it would form a hard, practically homogeneous substance, thus destroying the resiliency of the felt. The cement should be applied to the felt when quite thick, so that it will not soak into the felt.* Thus a laminated structure is produced comprising the two layers of cement, *with an intervening layer of felt forming the yielding or resilient substance.* Any desired form of cement may be used for this purpose and yielding or resilient substances other than felt could be employed which selections are obviously embraced in the scope of my invention."

Again, at line 108 to line 5 on page 2 of the specifications:

"At the back of the case, where the glass plates fasten to the wooden structure 9, as shown in Fig. 1, *the same fasteninig means, consisting of*

the laminated structure of felt and cement, is also employed with equally good results."

And again, at page 2, at lines 11 to 14:

"Parts which have been united in this manner cannot be separated without breaking the glass, except by running a sharp knife through the felt between the two layers of cement."

Again, at page 2, lines 19 to 56:

"The yielding nature of the felt cushion absorbs the sharpness of shocks on the case and obviates breakage which so frequently happens with all other forms of fastenings now known, particularly metallic corner-fastenings or structures in which a glass plate is grooved to receive the edge of another glass plate, which parts are united by cement at the groove, or show-cases in which the vertical glass plates are tightly fitted in grooved frames of wood or other material. In the latter structures severe shocks imparted directly to the front or side plates will fracture them, as a side plate has no interresiliency with the front plate or top frame; but the present invention avoids this difficulty, as there is inter-resiliency with both top and vertical plate which allows each plate to move relatively to the other, whether one plate alone is jarred or whether all plates are jarred simultaneously so that each plate vibrates its own degree and direction. The effect of this is particularly noticeable at the corners formed by the junction of three plates—the top plate, a side plate, and front plate—as at the corners referred to unless perfect cushioning of each plate is provided, a fracture is very likely to occur, resulting from the rigidity of the three-line joint and the unequal rate of vibration of

the respective three plates and the conflicting directions or planes of vibration centering at one point, and so far as I am aware, I am the

first inventor to provide a structure comprising glass plates arranged in three different planes, each plate meeting and joining the other two with *an intervening cushion between the joining faces, to which cushion the glass plates are cemented.*"

The claims of the patentee are two, as appears at lines 59 to 78 of page 2 of the specifications, and are as follows:

"1. A structure comprising a plurality of glass plates, the edges of which are spaced from the adjacent plates a felt cushion filling the space between the adjoining plates, the plates being cemented to the felt, each plate being adapted to freely vibrate in its natural plane of vibration, *and prevented by the felt cushion from imparting its vibration to the adjacent plates.*"

"2. A structure comprising a plurality of glass plates, an unconfined edge of one plate nearly, but not quite meeting another plate also with unconfined adjacent edge, *an elastic material filling the space thus existing between the nearest adjacent surfaces of the plates*, said plates being attached to the *elastic material*, whereby the plates *by reason of their unconfined edges and the intervening elastic material* can each vibrate or move in any direction independently."

It will be seen from the foregoing claims and the specifications referred to that the essential thing under the patent is the cushion joint and the mechanical method of constructing that joint.

While there are two claims set forth by the patentee as above stated, it would seem quite clear from a reading

of those claims that the only thing additional to the first claim that appears in the second claim is that the cushion which is attached to the glass plates by means of cement need not necessarily be felt, but may be any other resilient material of sufficient tensile strength to hold the plates of the case together. It would appear from the argument of counsel on the trial of this case and also from their opening brief on this appeal that they contend that under the second claim their patent precludes the use of any material for the construction of the joints that may be, when the joint is constructed, in a viscous or plastic form or condition; but, plainly the material that the patentee had in mind according to all of his specifications and his first claim that would in fact be used to perfect his cushion joints was felt, and that it very naturally occurred to him that rubber or some other material might be so manufactured hereafter as to have at once the resilient quality and sufficient tensile strength to serve the purpose subserved by the felt, and therefore, he properly covered that contingency by his second claim, but did not cover either hard or plastic material, simply inserting in the place of felt cushion the following: “An *elastic* material, filling the space thus existing between the nearest adjacent surface of the plates and *said plates being attached to the elastic material.*” And while the claim does not itself say “being attached by cement,” of course, inasmuch as the cases are constructed without bolts or metallic fasteners and

inasmuch as all of the specifications referred to the attachment by cement, that claim would probably be the same as the first claim with the exception that the cushion may be of a resilient material other than felt, which resilient material forms one of the layers of the laminated structure which layer is attached to the glass by cement. No other construction, it seems to us, can be placed upon this claim when read together with the first claim and this construction is conclusively established by the patentee himself in his statement above quoted, "any desired form of *cement* may be used for this purpose and yielding or resilient substance other than felt could be employed, which selections are obviously embraced in the scope of my invention."

In the answer of the respective defendants it was not alleged that the patent claimed by the plaintiff was invalid but the defense set up and the issue upon which the cases were tried, was that the show cases used by the defendant Webster Bros., and manufactured by the defendant Murray, were not cushion or resilient joint cases but the joints were constricted with cement which in the all-cement joints was plastic when applied, and hardened thereafter and made a perfectly rigid joint, and that in some instances a very liquid cement had been used, and for the purpose of preventing the pressure from causing the cement to exude from the joint before it hardened, a narrow, thin strip of felt was imbedded in the liquid cement that was first applied to one of the

adjacent edges of the glass and then completely saturated with the liquid cement in such condition that the cement penetrated the felt and thus constituted one homogeneous mass which hardened into a perfectly rigid joint, and that the felt was not placed in laminated form and afforded no cushion or resiliency whatsoever.

This, it will be noted, was exactly the thing that the patentee gave notice to the world would not be an infringement of his patent, and would be a useless and worthless structure, as will be noted from line 67 to line 73 of page 1 of the specification:

“If the cement were applied to the felt so as to permeate the same, by uniting with the felt it would form a hard, practically homogenous substance, THUS DESTROYING THE RESILIENCY OF THE FELT.”

The defendants in these two cases, as the evidence shows, regarded the patent as valid, but did not infringe the patent, but on the contrary, made a show-case that the patentee himself would regard as valueless because of the certainty that it would from the effects of change in temperature, or other cause, break the glass, and as stated in appellant's opening brief, the defendant Murray, the manufacturer, testified that he would not give a snap of his finger for the difference between the rigid joint constructed by him, either wholly of cement or with cement and felt, the cement being applied so as to permeate the felt and make a homogeneous mass equally

as hard and unresilient as the all-cement joint, and the joint patented.

During the course of the trial the court by consent of counsel, inspected all of the show cases in question and therefore was fully informed from personal observation of the exact character and quality of the joints in the show cases in question and as to whether or not they were rigid joints or resilient or cushion joints, and of course finding that they were all rigid joints, could come to no other conclusion than that the show cases were not within the patent in question.

It should be stated here, that for convenience in calling the court's attention to the particular matters contained in the specifications and claims, the writer of this brief has in proper places either italicized or capitalized where that form does not appear in the matters quoted.

The validity of this patent has been declared by this court in the case of Diamond Patent Company vs. S. E. Carr Company, and the opinion of the court was reported at page 400 of 217 Federal Reporter. In that case the contention of the defendant was that the patent was invalid for the reason that all glass show cases had been manufactured and commonly used by the public before the patent was issued and therefore it is apparent that the plaintiff in that case, who is the plaintiff in the cases at bar, was obliged to overcome the proof of the defendant as to manufacture and use of like show-cases prior to the issuance of the patent.

This court in its opinion at page 403 of the Report, discussed the very question that was at issue before the trial court in this case and determined there, at page 404, that *the idea which is at the basis of the Weber invention is an elastic medium between the plates.*

Reviewing the evidence in the case, at page 403, the Court said:

“Whitcomb testified that the cases he made for the Cooper Drug Company and Federman had felt joints, and that he used felt in the joints of these all-glass cemented cases ‘for the vibration of the case,’ and that he made some without the felt, simply stuck one plate of glass on the other and found it was so solid any little jar would break it, and then he thought of the felt to give the elastic movement and make an elastic joint, and he testified that, while the joints in those cases are not hard and fixed, they appear to be solid but, he added, ‘there must be some give to them or they would break.’ ”

The court continuing: “But the evidence is not convincing that Whitcomb’s idea in using the felt was to furnish an elastic cushion between the plates. It seems, rather, to indicate that his idea was to insert a porous medium between the plates which, when it became saturated with glue, would present a more effective binding of the plates than could have been accomplished by glue or paste alone, and that the rubber strips which he employed in one or two instances must also have been used for the purpose of making a firmer joint, for it is common knowledge that such rubber soon becomes hard and loses its resiliency. He admitted that at first his glue permeated the felt, and he said:

‘And then I got a felt that we had treated waterproof. I can’t think what we called it. You can take any piece of cloth and have the pieces sort of waterproofed so as to keep your cement from soaking through.’

But there is absolutely no evidence that in any of the show-cases for the Cooper or Federman drug store was there any use of a waterproof felt. If, indeed, Whitcomb ever employed waterproof felt it must have been at some subsequent experiment.”

It would appear clear from the foregoing that the contention of the plaintiff in that case, who is the plaintiff in this case, was at that time that the very structure that he now claims to be an infringement of his patent was not an anticipation, for the reason that the joints constructed which it was claimed were anticipations, were rigid and not resilient, even though they contained felt that in its original form was a cushion but when permeated with the cement, as in that case and as in the cases at bar, became a rigid, homogeneous mass, making a non-resilient joint, and this court, of course, adopted that view.

Further continuing at page 403, the court said:

“Mr. Federmann, who was called as a witness for the appellee, testified: ‘There is no elasticity in the joints at all; none that I know of.’ It is true that he further testified that whatever elasticity followed from the use of the felt in the joints between the glass existed in those show-cases, and that any elasticity resulting from the method of construction existed in those cases. That was merely to state a truism. *Its effect was not to show that there was elasticity in the joints, and it does not detract from*

the testimony of the witness that there was no elasticity in the joints. It may be conceded that, if there were any elasticity in joints in which the felt had been saturated by glue, Whitcomb secured it in the joints which he made, and which, as we have seen, were not satisfactory. To make such a joint was not to anticipate Weber's idea of using felt strips in combination with a plastic cement on each side thereof, which was of such quality as to hold, but not to penetrate the felt, and to leave it with all its natural elasticity as a cushion between the plates. It does not appear, therefore, that Whitcomb, in making his all-glass show-cases, had in mind the idea which is at the basis of the Weber invention, an elastic medium between the plates."

Further, the court in the opinion calls attention to the witness Whitcomb's testimony, as follows:

"That they were put together with some kind of composition which seemed to be a very hard substance after it dried and 'it made a hard solid joint' and Jackson, who repaired two of them, testified that the joints were 'solid and rigid.'

The court also in the opinion calls attention to the testimony of the secretary of the appellant in that case in which he said:

"What I call solid joints all through because the material used (I would call it glue) *would permeate the felt and make a hard joint.* Whatever material he used *permeated the felt* * * * * and the material used in the construction of the Federmann cases which (whatever it is) *permeates the felt making a solid jointed case*, which was not the case in the patent. It was simply the process of putting these plates together with an *elastic joint*; that is the substance of the patent, as I understand it."

Further in the opinion, the court says :

“It does not prove that Whitcomb conceived the idea of an elastic joint, or that, if he conceived it, he gave to the public the benefit thereof.”

After further discussing the matter of the resilient joint, in this opinion, the court says :

“This result could not be obtained without the use of an *adhesive cement that would not penetrate the cushion and destroy its elasticity*, and the specifications plainly call for the use of such cement. The appellee’s contention that the patentee can claim nothing beyond the terms of his claim and that he must be limited to the invention covered thereby, is well founded.”

Again the italics are our own.

It will be seen by the foregoing that the very contention now made by the appellant in these cases was refuted and overcome in the case just cited and the court there held that the same cases that the appellant now claims are infringements upon his patent, were not anticipations thereof, and that the value of the patent and the basic principle of the patent was the resilient, or cushion, joint. Upon the question of fact as to whether or not the joints in the cases now in litigation were resilient, when the evidence is analyzed reduces itself to this simple proposition laid down by the appellant and its witnesses. If a knife blade will penetrate a joint on an all-glass show-case, that joint is resilient; if the joint on an all-glass show-case is resilient, a knife blade will pen-

etrate that joint. The proof, therefore, as is contended by appellant that a joint is resilient, is simply that it can be penetrated with a knife blade, and the fact that the joint can be penetrated by a knife blade, may be established by proof that the joint is resilient. Just what system of logic this reason is based upon is hard of comprehension. Chalk may be penetrated by a knife blade, but certainly no person would venture to say from that fact that chalk is resilient or when placed between weights produces a cushion effect.

It will be observed that counsel for appellant and the expert witnesses for the appellant do not distinguish between the words "elastic" and "plastic" and therefore, claim that if the cement when put in place to form a hard joint is plastic when placed there, forms an elastic or resilient or cushion joint. "Plastic" is defined as being "capable of being modeled or molded into various forms, as clay, plaster," while "elastic" is defined as "having the power or property of returning or springing to the form from which it has been bent, pressed or distorted, having the inherent property or quality or regaining its natural form or volume after the removal of any external force which has altered that form or volume; springy; rebounding."

It will thus be seen that plastic and elastic for the purposes of this patent are directly opposite terms. Plastic material will yield and after the yielding to force will remain in the form to which it yielded, while on

the other hand an elastic material will yield to force but after the force is released, will re-assume its original form. Of course "resilient" is practically synonymous with "elastic."

As stated above in this brief, in addition to hearing the evidence which is before this court in open court, the trial judge personally inspected the show-cases in question and after inspecting them and hearing the evidence determined that the joints in those show-cases are not so made that "a laminated structure is produced composing the two layers of cement with intervening layer of felt, forming the yielding or resilient substance," but it finds in the cases where any material other than cement was used in the joint that the cement had been "applied to the felt so as to permeate the same by uniting with the felt," and that it had formed "a hard, practically homogeneous substance, thus destroying the resiliency of the felt." (Lines 67 to 71, page 1 Specifications of Letters Patent; Transcript, p. 16.)

Having so found, of course, the trial court found as testified by the witnesses that the joints in question were hard, rigid joints and as this court has determined in the one case cited in this brief that the same structure of joints then relied upon as anticipations of the invention covered by the patent were not laminated joints and were not cushion joints or resilient joints or elastic joints, and that they were, therefore, not in any sense anticipations of the invention covered by the patent,

we submit that the finding of the trial court as to both the facts and the law of the case was correct.

It is respectfully submitted that the judgment of the trial court should be affirmed.

Respectfully submitted,

M. G. Gallaher

Attorney for Appellees.